

APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	Group Art Unit: 2625
Tomasz F. Wilk	§	
	§	Examiner: Dulaney, Benjamin O.
Serial No.: 10/606,697	§	
	§	Atty Docket No.: RPS920030067US1
Filed: 06/26/2003	§	
	§	Customer No.: 56102
Title: Method For Monitoring Print Jobs	§	
In a Data Processing Network	§	Confirmation No.: 5049

Mail Stop: Appeal Brief-Patents

Commissioner for Patents

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APPEAL BRIEF**Honorable Commissioner:**

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of November 15, 2007 (hereinafter the "Office Action"), and pursuant to the Notice of Appeal filed February 15, 2008.

REAL PARTY IN INTEREST

The real party in interest in accordance with 37 CFR § 41.37(c)(1)(i) is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR § 41.37(c)(1)(ii).

STATUS OF CLAIMS

Status of claims in accordance with 37 CFR § 41.37(c)(1)(iii): Twenty-four (24) claims are filed in the original application in this case. Claims 3, 6, 13-15, 19, and 22 have been cancelled. Remaining claims 1, 2, 4, 5, 7-12, 16-18, 20, 21, 23, and 24 are rejected in the Office Action. Claims 1, 2, 4, 5, 7-12, 16-18, 20, 21, 23, and 24 are on appeal.

STATUS OF AMENDMENTS

Status of amendments in accordance with 37 CFR § 41.37(c)(1)(iv): No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Appellants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v). This summary includes a concise explanation of the subject matter defined in each of the independent claims involved in the appeal and includes references to the specification by page and line number and to the drawings by elements. The three independent claims involved in this appeal are claims 1, 12, and 17. Claims 1 recites a data processing network. Claim 12 recites a computer program product to manage print jobs on a data processing network. Claim 17 recites device aspects of the data processing network of claim 1.

Claim 1 recites a data processing network (Paragraph 0005, Paragraph 13, Figure 1, element 100). The data processing network of claim 1 includes a first printer connected to a network medium (Paragraph 0014, Figure 1, elements 110A and 110B). The data processing network of claim 1 also includes a set of print clients connected to the network medium wherein each print client is enabled to permit a user to submit a print job to the first printer (Paragraph 0013, Figure 1, elements 102A, 102B, 102C, and 102D). The data processing network of claim 1 also includes a first print job table to

store information indicative of first printer capacity available to the user, the first print job table being stored in a computer readable medium (Paragraph 0017, Figure 2, element 150). The data processing network of claim 1 also includes computer code means for determining whether to accept a new print job submitted by the user based on a comparison of the size of a new print job and the user's available first printer capacity (Paragraphs 0021-0025, Figure 3, elements 206 and 216). The data processing network of claim 1 also includes computer code means for updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold (Paragraphs 0017, 0018, 0021-0025, Figure 2, elements 150, 151A, 151B, 151N).

Claim 12 recites a computer product comprising a computer recordable medium having recorded on it a set of executable computer instructions for managing print jobs within a data processing network (Paragraph 0005, Paragraph 13, Figure 1, element 100). The computer product includes computer code means for detecting the submission of a new print job to a first network connected printer by a user (Paragraph 0020, Figure 3, element 202). The computer product also includes computer code means for responding to the submission by determining the size of the new print job and rejecting the new print job if the size exceeds a maximum size corresponding to the first printer (Paragraph 0021, Figure 3, elements 208, 208, and 210). The computer product also includes computer code means for comparing the size of the print job to the first printer capacity available to the user and processing the print job based on the comparison (Paragraphs 0021-0025, Figure 3, elements 206, 216, 217, and 218), wherein the first printer capacity available to the user is indicative of the size of any pending print jobs of the user (Paragraphs 0021-0025, Figure 3, elements 206, 216), and the code for comparing includes code means for accessing a first print job table containing a set of entries wherein each entry corresponds to a respective user and is indicative of the size of any pending print jobs submitted by the user (Paragraphs 0021-0025, Figure 2, elements 150, 151A, 151B, 151N, Figure 3, elements 205, 206, 216, and 218) and modifying the first print job table to reflect changes in the size of any pending print jobs submitted by the

user, including deleting a user's entry in the first print job table responsive to determining that the user's available capacity is equal to or greater than a threshold value (Paragraphs 0017, 0018, 0021-0025, Figure 2, elements 150, 151A, 151B, 151N, Figure 3, elements 205, 206, and 218).

Claim 17 recites a print job processing device for use in a data processing network. The device includes means for communicating with a set of print clients via a network medium to enable a user to submit a print job to a first network attached printer via the device (Paragraph 0014, Figure 1, elements 100, 104, 110A, 110B). The device also includes a first print job table to store information indicative of first printer capacity available to the user, the first print job table being stored in a computer readable medium of the device (Paragraph 0017, Figure 2, element 150). The device also includes computer code means for determining whether to accept a new print job submitted to the first printer based on a comparison of the size of the new print job and the user's first available printer capacity (Paragraphs 0021-0025, Figure 3, elements 206 and 216). The device also includes computer code means for updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available printer capacity is equal to or greater than a predetermined threshold (Paragraphs 0017, 0018, 0021-0025, Figure 2, elements 150, 151A, 151B, 151N, Figure 3, elements 205, 206, and 218).

GROUND OF REJECTION

In accordance with 37 CFR § 41.37(c)(1)(vi), Appellants provide the following concise statement for each ground of rejection:

1. Claims 1, 5, 7, 8, 10, 12, 17, 21, and 24 stand rejected under 35 U.S.C. § 102(b) over Takimoto, (U.S. Patent 6,202,092).
2. Claims 2, 9, and 18 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Takimoto as applied to claim 1, in view of Bauer, *et al.*

(U.S. Patent 5,819, 047).

3. Claims 4 and 20 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Takimoto as applied to claim 1, in view of Salgado (U.S. Patent 5,777,882).
4. Claims 11 and 23 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Takimoto, in view of Homma (U.S. Patent Publication No. 2001/0017700).
5. Claim 16 is rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Takimoto in view of Sommer, *et. al.* (U.S. Patent 7,158,244).

ARGUMENT

Appellants present the following argument pursuant to 37 CFR § 41.37(c)(1)(vii) regarding the grounds of rejection on appeal in the present case.

Argument Regarding The First Ground Of Rejection On Appeal: Claims 1, 5, 7, 8, 10, 12, 17, 21, and 24 Are Rejected Under 35 U.S.C. § 102(b) Over Takimoto

Claims 1, 5, 7, 8, 10, 12, 17, 21, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Takimoto. To anticipate claims 1, 5, 7, 8, 10, 12, 17, 21, and 24 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Takimoto must disclose each and every element as set forth in Appellant's claims. The second requirement of anticipation is that Takimoto must enable Appellant's claims. Takimoto does not meet either requirement and therefore does not anticipate Appellant's claims.

**Takimoto Does Not Disclose Each And Every Element
Of The Claims Of The Present Application**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Independent claim 1 of the present application recites:

1. A data processing network, comprising:

a first printer connected to a network medium;

a set of print clients connected to the network medium, wherein each print client is enabled to permit a user to submit a print job to the first printer;

a first print job table to store information indicative of first printer capacity available to the user, the first print job table being stored in a computer readable medium; and

computer code means for:

determining whether to accept a new print job submitted by the user based on a comparison of the size of the new print job and the user's available first printer capacity, and

updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold.

As explained in more detail below, Takimoto does not disclose each and every element of claim 1, and Takimoto therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102(b).

**Takimoto Does Not Disclose Updating the Available Capacity
Information, Including Deleting a First Print Job Table Entry
Corresponding to the User Responsive to Determining That the User's
Available First Printer Capacity is Equal to or Greater than a
Predetermined Threshold**

The Office Action takes the position that Takimoto at figure 1, item 22, column 3, lines 66-67, and column 5, lines 3-19 and 30-35 discloses: updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold. Appellants respectfully note that Takimoto at column 3, lines 47-51 describes element 22 of figure 1 as:

The printer driver 22 of the server computer 2 includes a print request analyzing portion 22a, a security validating portion 22b, an interface 22c for a manager, a statistical information managing portion 22d, and a drawing processing portion 22e.

In addition, Appellants note that what Takimoto at column 3, lines 66-67 in fact discloses is:

The security validating portion 22b compares the result of analysis by the print request analyzing portion 22a with the information pertaining to the user, and, if requirements for printing are not satisfied, rejects the print request.

In addition, what Takimoto at column 5, lines 3-19 and 30-35 in fact discloses is:

If the request is a print request, the print request analyzing portion 22a judges from the print data the number of pages in the print job, which kind of paper or paper feeder (not shown) the user is requesting, and which, if any, special printing function is requested (step S7 in FIG. 2). With regard to the respective requests, the security validating portion 22b determines

whether the requests are within the limits on the number of pages (step S8 in FIG. 2) and whether any requested special printing functions are allowed or not (step S9 in FIG. 2) based on the stored authority and statistical information of the user in the security data base, and decides authorization or non-authorization to print.

If the print request satisfies all the requirements, the security validating portion 22b authorizes printing by printer 3. If the print request fails to satisfy one or more of the requirements, the security validating portion 22b does not authorize the requested print job, and an error indication is given (step S12 in FIG. 2).

...

When the printer 3 prints, the statistical information managing portion 22d adds the number of printed pages with regard to each kind of paper or paper feeder and the number of times a special printing function is used to the cumulative total for these values, and updates the security data base with the result of the addition (step S11 in FIG. 2).

That is, Takimoto at element 22 of figure 1 discloses a print driver having certain components. Takimoto at column 3, lines 66-67 discloses a print driver performing security validation by rejecting a print request if information requirements pertaining to a user are not satisfied. Takimoto at column 5, lines 3-19 discloses authorizing or non-authorizing a print request based on paper requirements, page limits, and security information. Takimoto at column 5, lines 30-35 discloses updating a security database with the number of printed pages with regard to each kind of paper or paper feeder and the number of times a special printing function is used when the printer prints. These disclosures by Takimoto, however, do not disclose updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold. Takimoto at the cited reference points does not disclose deleting any entry from the print job table as claimed by Appellants. The Office Action at page 2 states that Takimoto's rejection of a print request is analogous to deletion as the job will no longer be contained in the print driver. Appellants note, however, that the Office Action incorrectly characterizes Takimoto's rejecting a print request as analogous to deleting an entry from the print job table as claimed. Each entry

in the print job table corresponds to a *particular user or client*, and deleting an entry from the print job table as claimed is an indication that a user or client has all of their maximum printer capacity. *See* Appellant's Original Specification at paragraphs 0017, 0018. Therefore, Appellant's print job table only reflects those users or clients who have submitted print jobs that are still pending or being processed. *Id.* In stark contrast, Takimoto's print driver rejects a *print request* if information requirements are not satisfied. Furthermore, Takimoto's print driver cannot said to be analogous to the print job table as presently claimed because Takimoto's print driver does not contain entries corresponding to users or clients. Because Takimoto does not disclose each and every element and limitation of Appellant's claims, Takimoto does not anticipate Appellant's claims and the rejections under 35 U.S.C. § 102(b) should be withdrawn.

**Takimoto Does Not Enable Each and Every Element
Of The Claims Of The Present Application**

Not only must Takimoto disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Appellant's claims, but also Takimoto must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the Appellant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Takimoto places Appellant's claims in the possession of a person of ordinary skill in the art, Takimoto is legally insufficient to anticipate Appellant's claims under 35 U.S.C. § 102(b). As explained above, Takimoto does not disclose each and every element and limitation of independent claim 1 of the present application. Because Takimoto does not disclose each and every element and limitation of the independent claims, Takimoto cannot possibly place the elements and limitations

of independent claim 1 in the possession of a person of ordinary skill in the art. Takimoto cannot, therefore, anticipate claim 1 of the present application.

Relations Among Claims

Independent claims 12 and 17 claim computer product and apparatus aspects of the method claimed in independent method claim 1. For the same reason that Takimoto does not disclose or enable independent claim 1, Takimoto does not disclose or enable independent claims 12 and 17. Independent claims 12 and 17 are therefore patentable and should be allowed.

Claims 5, 7, 8, 10, 21, and 24 depend respectively from independent claims 1, 12, and 17. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Takimoto does not disclose or enable each and every element of the independent claims, Takimoto does not disclose or enable each and every element of the dependent claims of the present application. As such, claims 5, 7, 8, 10, 21, and 24 are also patentable and should be allowed.

Argument Regarding The Second Ground Of Rejection On Appeal: Claims 2, 9, And 18 Are Rejected Under 35 U.S.C. § 103(a) As Being Unpatentable Over Takimoto In View Of Bauer

Claims 2, 9, and 18 stand rejected under as being unpatentable over Takimoto in view of Bauer, *et. al.* (U.S. Patent No. 5,819,047). The question of whether Appellant's claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of other. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-1730 (2007). Although Appellants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Appellant's claims under for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 2, 9, and 18. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 2 and 9 depend from independent claim 1 and include all the limitations of the independent claim from which they depend. Dependent claim 18 depends from independent claim 17 and includes all the limitations of the independent claim from which it depends. In rejecting dependent claims 2, 9, and 18, the Office Action relies on Takimoto as disclosing each and every element of independent claims 1, 12, and 17. As shown above, Takimoto in fact does not disclose each and every element of independent claims 1, 12, and 17. Because Takimoto does not disclose each and every element of independent claims 1, 12, and 17, the proposed combination of Bauer with Takimoto cannot possibly disclose each and every element of dependent claims 2, 9, and 18. The proposed combination of Bauer with Takimoto, therefore, cannot establish a prima facie case of obviousness, and the rejections of claims 2, 9, and 18 under U.S.C. § 103(a) should be withdrawn.

In addition to the fact that the Office Action has not established a prima facie of obviousness there is at least another reason that the rejections of claims 2, 9, and 18 should be withdrawn: The Office Action does not examine Appellant's claims in light of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). As mentioned above, the question of whether Appellant's claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). "To facilitate review, this analysis should be made explicit." *KSR*, slip op. at 14 (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). That is, the Office Action must make explicit an analysis of the factual inquiries set forth in *Graham*. In present case, however, the Office Action does not even mention the factual inquiries set forth in

Graham. As such, the rejections of claims 2, 9, and 18 under 35 U.S.C. § 103 are improper and should be withdrawn.

**Argument Regarding The Third Ground Of Rejection On Appeal:
Claims 4 And 20 Are Rejected Under 35 U.S.C. § 103(a)
As Being Unpatentable Over Takimoto In View Of Salgado**

Claims 4 and 20 stand rejected under as being unpatentable over Takimoto in view of Salgado (U.S. Patent No. 5,777,882). The question of whether Appellant's claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of other. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-1730 (2007). Although Appellants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Appellant's claims under for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 4 and 20. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claim 4 depends from independent claim 1 and includes all the limitations of the independent claim from which it depends. Dependent claim 20 depends from independent claim 17 and includes all the limitations of the independent claim from which it depends. In rejecting dependent claims 4 and 20, the Office Action relies on Takimoto as disclosing each and every element of independent claims 1, 12, and 17. As shown above, Takimoto in fact does not disclose each and every element of independent claims 1, 12, and 17. Because Takimoto does not disclose each and every element of independent claims 1, 12, and 17, the proposed combination of Salgado with Takimoto cannot possibly disclose each and every element of dependent claims 4 and 20. The proposed combination of Salgado with Takimoto, therefore, cannot establish a prima

facie case of obviousness, and the rejections of claims 4 and 20 under U.S.C. § 103(a) should be withdrawn.

In addition to the fact that the Office Action has not established a prima facie of obviousness there is at least another reason that the rejections of claims 4 and 20 should be withdrawn: The Office Action does not examine Appellant's claims in light of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). As mentioned above, the question of whether Appellant's claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). "To facilitate review, this analysis should be made explicit." *KSR*, slip op. at 14 (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). That is, the Office Action must make explicit an analysis of the factual inquiries set forth in *Graham*. In present case, however, the Office Action does not even mention the factual inquiries set forth in *Graham*. As such, the rejections of claims 4 and 20 under 35 U.S.C. § 103 are improper and should be withdrawn.

**Argument Regarding The Fourth Ground Of Rejection On Appeal:
Claims 11 And 23 Are Rejected Under 35 U.S.C. § 103(a)
As Being Unpatentable Over Takimoto In View Of Homma**

Claims 11 and 23 stand rejected under as being unpatentable over Takimoto in view of Homma (U.S. Patent Publication No. 2001/001770). The question of whether Appellant's claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of other. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-1730 (2007). Although Appellants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless

demonstrate a prima facie case of obviousness to reject Appellant's claims under for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 11 and 23. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claim 11 depends from independent claim 1 and includes all the limitations of the independent claim from which it depends. Dependent claim 23 depends from independent claim 17 and includes all the limitations of the independent claim from which it depends. In rejecting dependent claims 11 and 23, the Office Action relies on Takimoto as disclosing each and every element of independent claims 1, 12, and 17. As shown above, Takimoto in fact does not disclose each and every element of independent claims 1, 12, and 17. Because Takimoto does not disclose each and every element of independent claims 1, 12, and 17, the proposed combination of Homma with Takimoto cannot possibly disclose each and every element of dependent claims 11 and 23. The proposed combination of Homma with Takimoto, therefore, cannot establish a prima facie case of obviousness, and the rejections of claims 11 and 23 under U.S.C. § 103(a) should be withdrawn.

In addition to the fact that the Office Action has not established a prima facie of obviousness there is at least another reason that the rejections of claims 11 and 23 should be withdrawn: The Office Action does not examine Appellant's claims in light of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). As mentioned above, the question of whether Appellant's claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). "To facilitate review, this analysis should be made explicit." *KSR*, slip op. at 14

(citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). That is, the Office Action must make explicit an analysis of the factual inquiries set forth in *Graham*. In present case, however, the Office Action does not even mention the factual inquiries set forth in *Graham*. As such, the rejections of claims 11 and 23 under 35 U.S.C. § 103 are improper and should be withdrawn.

**Argument Regarding The Fifth Ground Of Rejection On Appeal:
Claim 16 Is Rejected Under 35 U.S.C. § 103(a)
As Being Unpatentable Over Takimoto In View Of Sommer**

Claim 16 stands rejected under as being unpatentable over Takimoto in view of Sommer (U.S. Patent No. 7,158,244). The question of whether Appellant's claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of other. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-1730 (2007). Although Appellants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Appellant's claims under for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claim 16. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claim 16 depends from independent claim 12 and includes all the limitations of the independent claim from which it depends. In rejecting dependent claim 16, the Office Action relies on Takimoto as disclosing each and every element of independent claims 1, 12, and 17. As shown above, Takimoto in fact does not disclose each and every element of independent claims 1, 12, and 17. Because Takimoto does not disclose each and every element of independent claims 1, 12, and 17, the proposed combination of Sommer with Takimoto cannot possibly disclose each and every element of dependent claim 16. The proposed combination of Sommer with Takimoto, therefore, cannot establish a prima

facie case of obviousness, and the rejection of claim 16 under U.S.C. § 103(a) should be withdrawn.

In addition to the fact that the Office Action has not established a prima facie of obviousness there is at least another reason that the rejection of claim 16 should be withdrawn: The Office Action does not examine Appellant's claims in light of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). As mentioned above, the question of whether Appellant's claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). "To facilitate review, this analysis should be made explicit." *KSR*, slip op. at 14 (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). That is, the Office Action must make explicit an analysis of the factual inquiries set forth in *Graham*. In present case, however, the Office Action does not even mention the factual inquiries set forth in *Graham*. As such, the rejection of claim 16 under 35 U.S.C. § 103 is improper and should be withdrawn.

Conclusion of Appellant's Arguments

Claims 1, 5, 7, 8, 10, 12, 17, 19, 21, and 24 stand rejected under 35 U.S.C. § 102 as being anticipated by Takimoto. As explained above, Takimoto does not disclose or enable each and every element of Appellant's claims. Takimoto therefore does not anticipate Appellant's claims. Claims 1, 5, 7, 8, 10, 12, 17, 19, 21, and 24 are therefore patentable and should be allowed. Appellants respectfully request reconsideration of claims 1, 5, 7, 8, 10, 12, 17, 19, 21, and 24.

Claims 2, 9, and 18 stand rejected under 35 U.S.C. § 103 as being obvious over Takimoto in view of Bauer. As explained above, the combination of Takimoto and Bauer does not

teach or suggest each and every element of Appellant's claims and the Office Action does not support the rejections by making explicit an analysis of the factual inquiries set forth in *Graham*. Claims 2, 9, and 18 are therefore patentable and should be allowed.

Appellants respectfully request reconsideration of claims 2, 9, and 18.

Claims 4 and 20 stand rejected under 35 U.S.C. § 103 as being obvious over Takimoto in view of Salgado. As explained above, the combination of Takimoto and Salgado does not teach or suggest each and every element of Appellant's claims and the Office Action does not support the rejections by making explicit an analysis of the factual inquiries set forth in *Graham*. Claims 4 and 20 are therefore patentable and should be allowed. Appellants respectfully request reconsideration of claims 4 and 20.

Claims 11 and 23 stand rejected under 35 U.S.C. § 103 as being obvious over Takimoto in view of Homma. As explained above, the combination of Takimoto and Homma does not teach or suggest each and every element of Appellant's claims and the Office Action does not support the rejections by making explicit an analysis of the factual inquiries set forth in *Graham*. Claims 11 and 23 are therefore patentable and should be allowed. Appellants respectfully request reconsideration of claims 11 and 23.

Claim 16 stands rejected under 35 U.S.C. § 103 as being obvious over Takimoto in view of Sommer. As explained above, the combination of Takimoto and 16 does not teach or suggest each and every element of Appellant's claim and the Office Action does not support the rejection by making explicit an analysis of the factual inquiries set forth in *Graham*. Claim 16 is therefore patentable and should be allowed. Appellants respectfully request reconsideration of claim 16.

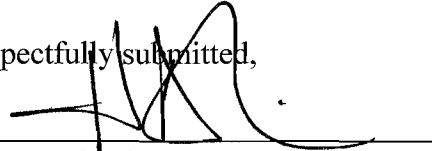
In view of the arguments above, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 50-0563 for any fees required or overpaid.

Date: March 18, 2008

By:

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'H. Artoush Ohanian', written over a horizontal line.

H. Artoush Ohanian

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ATTORNEY FOR APPELLANTS

**APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
THOMAS FRANCISZCK WILK, SERIAL NO. 10/606,697**

CLAIMS

What is claimed is:

1. A data processing network, comprising:
 - a first printer connected to a network medium;
 - a set of print clients connected to the network medium, wherein each print client is enabled to permit a user to submit a print job to the first printer;
 - a first print job table to store information indicative of first printer capacity available to the user, the first print job table being stored in a computer readable medium; and
 - computer code means for:
 - determining whether to accept a new print job submitted by the user based on a comparison of the size of the new print job and the user's available first printer capacity, and
 - updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold.

2. The network of claim 1, wherein the available capacity information is indicative of the difference between a print quota associated with the user and the remaining size of all pending print jobs submitted by the user.
3. (Cancelled)
4. The network of claim 1, wherein the code means for updating the available capacity information includes code means for periodically adjusting the available capacity information of each user based on an approximation of the amount of print processing that has occurred since a previous period.
5. The network of claim 1, wherein the code means for updating the available capacity information is further characterized as code means for determining the actual amount of capacity required to process the user's pending print jobs.
6. (Cancelled)
7. The network of claim 1, wherein the first print job table includes an entry for every user authorized to submit print jobs to the first printer.
8. The network of claim 1, further comprising code means for rejecting a newly submitted print job if the size of the print job exceeds a predetermined maximum print job size associated with the printer.
9. The network of claim 1, further comprising a second printer connected to the network and available to the user for submitting print jobs and a second print job table to store information indicative of second printer capacity available to the user, the second print job table being stored in a computer readable medium.

10. The network of claim 1, further comprising a first print server connected between the network medium and the first printer, wherein the first print job table and the computer code means are stored in a storage medium of the first print server.

11. The network of claim 1, wherein the first print job table and the computer code means are stored in a storage medium of the first printer.

12. A computer product comprising a computer readable medium having recorded upon it a set of computer executable instructions for managing print jobs within a data processing network, the computer executable instructions further comprising:

computer code means for detecting the submission of a new print job to a first network connected printer by a user;

computer code means for responding to the submission by determining the size of the new print job and rejecting the new print job if the size exceeds a maximum size corresponding to the first printer; and

computer code means for comparing the size of the print job to the first printer capacity available to the user and processing the print job based on the comparison, wherein:

the first printer capacity available to the user is indicative of the size of any pending first print jobs of the user, and

the code means for comparing includes code means for:

accessing a first print job table containing a set of entries wherein each entry corresponds to a respective user and is indicative of the size of any pending print jobs submitted by the user, and

modifying the first print job table to reflect changes in the size of any pending print jobs submitted by the user, including deleting a user's entry in the first print job table responsive to determining that the user's available capacity is equal to or greater than a threshold value.

13-15. (Cancelled)

16. The computer product of claim 12, wherein the code means for modifying the first print job table to reflect changes in the size of any pending print jobs includes code means for estimating progress made on the pending print jobs based at least in part on the amount of time elapsed since submission of the print job.

17. A print job processing device for use in a data processing network, comprising:

means for communicating with a set of print clients via a network medium to enable a user to submit a print job to a first network attached printer via the print job processing device;

a first print job table to store information indicative of first printer capacity available to the user, the first print job table being stored in a computer readable medium of the print job processing device; and

computer code means for:

determining whether to accept a new print job submitted to the first printer by the user based on a comparison of the size of the new print job and the user's available first printer capacity, and

updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's

available first printer capacity is equal to or greater than a predetermined threshold.

18. The print job processing device of claim 17, wherein the available capacity information is indicative of the difference between a print quota associated with the user and the remaining size of all pending print jobs submitted by the user.
19. (Cancelled)
20. The print job processing device of claim 17, wherein the code means for updating the available capacity information includes code means for periodically adjusting the available capacity information of each user based on an approximation of the amount of print processing that has occurred since a previous period.
21. The print job processing device of claim 17, wherein the code means for updating the available capacity information is further characterized as code means for determining the actual amount of capacity required to process the user's pending print jobs.
22. (Cancelled)
23. The print job processing device of claim 17, wherein the print job processing device is further characterized as the first network attached printer.
24. The print job processing device of claim 17, wherein the print job processing device is further characterized as a first print server connected between the first printer and the network.

**APPENDIX OF EVIDENCE
ON APPEAL IN PATENT APPLICATION OF
THOMAS FRANCISZCK WILK, SERIAL NO. 10/606,697**

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the Appellants.

RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x).
There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).